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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,771	12/28/2001	Ulrich Wernz	WERNZ - 1	9032

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EXAMINER

MACKEY, JAMES P

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/033,771	Applicant(s) WERNZ, ULRICH	
	Examiner James Mackey	Art Unit 1722	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: 13-15 and 17-19.

Claim(s) rejected: 1-12, 16, 20 and 21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other:


 James Mackey
 Primary Examiner
 Art Unit: 1722 9/10/04

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejections under 35 USC 112, second paragraph would be overcome upon entering of the proposed amendment; note that upon entering of the proposed amendment, claims 13-15 and 17-19 would be objected to as depending upon a rejected base claim.

Continuation of 5. does NOT place the application in condition for allowance because: the use of the cylinder of Hettinga to "effect[s] just a short stroke" relates only to the intended use of the claimed apparatus structure, since said cylinder has "one common chamber" as recited in claim 3, and whether this common cylinder chamber is theoretically divided into two volumes ("stroke volume" and "pre-tensioning volume") and how such volumes are intended to be utilized relate only to the intended operation of the apparatus structure, which does not patentably distinguish the claimed apparatus structure; see *In re Finsterwalder*, 168 USPQ 530, *In re Casey*, 152 USPQ 235, *Ex parte Masham*, 2 USPQ2d 1647. Also, the "need for excavations or similar workings beneath the machine bed" is not precluded by the instant claims, even if such a presumption is correct (however, note the disclosure of Putzler, which does not show a pressure piece protruding through the counterpressure plate). Applicant's argument that pressure piece 20 of Putzler "is necessary to be able to adjust the machine to the respective die height" does not appear correct, since the horizontally movable pressure plate 17 (and specifically the threaded engagement of die 19 with threaded sleeve 18) is adjustable; also note that such a movable pressure plate of Putzler corresponds to the movable pressure cylinder 58 of Hettinga. Finally, claim 4 remains objected to for failure to further limit the subject matter of a previous claim, since whether or not the structure of the apparatus allows the apparatus to be operated in a certain way does not affect the conclusion that a claim merely recites an intended use of a previously-recited apparatus structure (note that the proposed amendment to claim 3, reciting structure that the machine has--e.g., one common chamber--does further limit the subject matter of a previous claim).